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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,472	07/11/2003	David J. Mester	01-1-129	3461

7590

01/11/2005

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,472

Applicant(s)

MESTER, DAVID J.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01032005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. In the amendment filed 10/13/04, the following has occurred: no claims have been added, canceled, nor amended. Now, claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-13, 15-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2003/0061104 to Thomason in view of US Patent Application Publication 2003/0167191 to Slabonik.

4. Claims 1, 3-13, 15-16 and 18 are rejected for the same reasons set forth in the previous Office Action, mailed 6/8/04, incorporated herein by reference.

5. Claims 2 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson in view of Slabonik as applied to Claim 1 and in further view of US Patent Number 5,307,262 to Ertel.

6. Claims 2 and 19-20 are rejected for the same reasons set forth in the previous Office Action, mailed 6/8/04, incorporated herein by reference.

7. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson in view of Slabonik and in further view of US Patent Application Publication 2001/0034722 to Tidball.

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8. Claims 14-17 are rejected for the same reasons set forth in the previous Office Action, mailed 6/8/04, incorporated herein by reference.

Response to Arguments

9. In the remarks filed 10/13/04, Applicants argue in substance that (1) there is no motivation provided in Thomson, Slabonik, or Ertel to combine their teachings; (2) Thomson, Slabonik, and Ertel references do not suggest the claimed invention as a whole; (3) the rejections improperly rely on hindsight reasoning; (4) Ertel does not process records individually as would be required in the management of warranty claims.

10. In response to Applicants' argument (1), the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, in this case, the Examiner respectfully submits that support for the motivation to combine the references has been found within the teachings of Slabonik and Ertel. In particular, sections 10-11 of Slabonik and column 2, lines 49-51 of Ertel.

11. In response to Applicants' argument (2), the Examiner agrees with Applicants that the combination of references must teach the claimed invention as a whole. However, it is respectfully submitted that Applicants' support for this argument, Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383 (Fed. Cir. 1986), dealt with a situation in which a large number of references were relied upon to suggest the claimed subject matter but did not specifically disclose all of the claimed elements. Here, the Examiner has relied upon specific

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references for teaching specific limitations recited in the claims and, further, provided specific motivation to combine them. Therefore, it is respectfully submitted that all of the claim elements have been addressed and, furthermore, that Hybritech Inc. v. Monoclonal Antibodies, Inc. is not applicable to the present situation because of the different circumstances discussed.

12. In response to Applicants' argument (3), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it is submitted that the Examiner has not relied upon improper hindsight reasoning as evidenced by the portions of the references cited in support of the proposed combinations.

13. In response to Applicants' argument (4), it is noted that the claims do not require individual processing of claims, rather, the claims recite that "all approved claims" are reviewed for accuracy. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it is respectfully submitted that the Examiner is only relying upon accuracy and completeness review feature of Ertel and not an overall batch processing element. Clearly, such data checking as taught by Ertel could be combined with Thomson as described in the above rejections.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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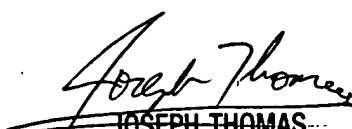
15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CLG
1/5/04


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